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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/370,601	08/10/1999	KRISTINE B. FUIMAONO	34063/KMO/W1	8267

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EXAMINER

RODRIGUEZ, CRIS LOIREN

ART UNIT PAPER NUMBER

3763

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/370,601

Applicant(s)

FUIMAONO, KRISTINE B.

Examiner

Cris L. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-39, 41-49, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) 24-39 and 41-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-23, 48, 49, 51, 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

*Claim Rejections - 35 USC § 103*

1. Claims 2-4, 6-12, 14-23, 48, 49, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorentzen (US 5,951,546) in view of Panescu et al (US 6,056,745).

Lorentzen discloses an electro surgical instrument for tissue ablation having a probe body 10 with an ablation electrode made of stainless steel, means for introducing fluid into the inner cavity (pump not shown), and a handle at 20. The probe body is generally rigid from its proximal to its distal end, and defines an inner cavity where cooling water pass within the cavity (Fig. 2a). However, Lorentzen fails to disclose the ablation electrode having an irrigation opening to pass the fluid from the inner cavity to the outside of the ablation electrode, and the length and the diameters of the electrode and probe body as claimed.

Panescu teaches ablation catheters (fig. 2a and 6) having a catheter body 22, a cooling assembly, and an electrode 16. Panescu teaches that the electrodes can have open or close end as shown. The electrodes, in figure 2a and 6, are cooled during ablation. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include Panescu's openings into Lorentzen's ablation instrument. Doing so would have cooled the electrode, and further the tissue area to avoid charring. Furthermore, the instant disclosure describes the length and diameters dimensions as being merely preferable, and does not describe it as contributing any unexpected result to the probe. As such, these parameters are deemed matters of design choice (lacking in

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any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results

2. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorentzen in view of Panescu et al ('745), and further in view of Ashley (6,176,857).

Lorentzen/Panescu discloses the invention substantially as claimed as discussed above. However, Lorentzen/Panescu fails to disclose the stainless steel tubular electrode being malleable.

Ashley teaches a surgical instrument, (fig 4A-6A), where the tip and tubular shaft probe 404 (electrode) is made of the same tubing (such as a metal conducting shaft), and the shaft can be malleable stainless steel (col. 8 lines 40-59). Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Ashley's malleable stainless steel material into Lorentzen/Panescu's catheter. Doing so would have improved the catheter conformation, particular for the patient's body, to access the location to be treated.

#### *Response to Arguments*

3. Applicant's arguments filed December 26, 2002 have been fully considered but they are not persuasive.
4. In response to applicant's argument that there is no motivation to modify Lorentzen's device to have an electrode with irrigation openings because would destroy its intended function, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability

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when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine Lorentzen and Panescu is that both references are tissue ablation devices in which Lorentzen discloses a closed electrode with a re-circulation cooling system, and Panescu discloses both open and closed electrodes with water cooling systems (for the closed electrode the fluid is re-circulated and the open one cools the area adjacent the electrode). Therefore, given the teachings, it would have been obvious to modify Lorentzen's device with the teachings of Panescu.

#### *Conclusion*

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

February 25, 2003



Cris L. Rodriguez  
Examiner  
Art Unit 3763



BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
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